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EXAMINER

YOUNG, JOHN L

ART UNIT

PAPER NUMBER

3622

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26

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. <b>09/379,167</b>	Applicant(s) <b>Eisen et al.</b>
Examiner <b>John Young</b>	Art Unit <b>3622</b>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on Feb 3, 2003

2a)  This action is FINAL. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 1-52 and 75-82 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-52 and 75-82 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on Feb 3, 2003 is: a)  approved b)  disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) 5)  Notice of Informal Patent Application (PTO-152)

3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

6)  Other: \_\_\_\_\_

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## **REJECTION ON RCE ( PAPER # 26 )**

### **37 CFR 1.126 Numbering of Claims**

1. **Claims 1-52 and 75-82 are pending. The originally filed claims were claims 1-74; paper# 20 canceled claims 53-74. Newly added claims 53-60 are renumbered as claims 75-82 and appropriate changes were also made to dependencies pursuant to 37 CFR 1.126. If Applicant intends to add additional claims they should begin with claim number 83.**

**When the application is ready for allowance, the Examiner, if necessary, will renumber the claims consecutively in the order in which they appear or in such order as may have been requested by Applicant.**

### **DRAWINGS**

2. The proposed drawing corrections filed on 02/03/2003 (Paper#25 with paper#15) are entered.

### **CLAIM REJECTIONS — 35 U.S.C. §112 ¶ 2**

3. **Rejections Withdrawn.**

### **CLAIM REJECTIONS — 35 U.S.C. §103(a)**

4. **Rejections Maintained.**

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**CLAIM REJECTIONS — 35 U.S.C. §103(a)**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1-52 are rejected under 35 U.S.C. §103(a) as being unpatentable over Capiel, US 6,449,634 (09/10/2002) [US f/d: 01/29/1999] (herein referred to as “Capiel”)

As per claim 1, Capiel (col. 12, ll. 53-61; and col. 13, ll. 10-25) discloses: “*sensor server program*’ with parameters ‘*E-mail address*’ and ‘*unique mail code*’ . . . .” and “*member\_id int. . . .*”

Capiel (col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) shows elements that suggest: “A method for electronically identifying a consumer without requiring consumer registration, the method comprising: embedding a unique identifier within a web site address, the unique identifier uniquely identifying an email recipient; including the web site address in an electronic mail message sent to the email recipient, wherein the web site address provides the email recipient with access to one or more web sites; establishing a connection between a client computer used by the email recipient to receive the email and a server computer providing access to the one or more web sites in the electronic mail message; providing the unique identifier to the server computer by way of sending the web site address to the server computer in a request submitted by the client computer to access said one or more web sites,

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independent from any consumer profile information previously stored on the client computer; parsing the web site address in the request to retrieve the unique identifier embedded in the web site address; identifying the email recipient based on the retrieved unique identifier. . . .”

Capiel (col. 1, ll. 55-60) shows elements that suggest “tracking the email recipient’s movement within the one or more web sites by associating the unique identifier with information that defines consumer activity within said one or more web sites.”

Capiel lacks an explicit recitation of “providing the unique identifier to the server computer by way of sending the web site address to the server computer in a request submitted by the client computer to access said one or more web sites, independent from any consumer profile information previously stored on the client computer; parsing the web site address in the request to retrieve the unique identifier embedded in the web site address; identifying the email recipient based on the retrieved unique identifier. . . .”

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Capiel (col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) would have been selected in accordance with “providing the unique identifier to the server computer by way of sending the web site address to the server computer in a request submitted by the client computer to access said one or more web sites, independent from any consumer profile information previously stored on the client computer; parsing the web site address in the request to retrieve the

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unique identifier embedded in the web site address; identifying the email recipient based on the retrieved unique identifier. . . .” because such selection would have provided means “*to identify the audience and tailor the advertising to that audience.*” (See Capiel (col. 1, ll. 22-24)).

As per claim 2, Capiel shows the method of claim 1. (See the rejection of claim 1 supra).

Capiel (col. 1, ll. 55-60) shows elements that suggest “tracking the email recipient’s movement within said one or more web sites. . . .” Capiel (col. 1, ll. 55-60; col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) shows elements that suggest “extracting the information that defines consumer activity based on said association to track consumer movement.”

Capiel (col. 12, ll. 9-43) shows elements that suggest “storing in at least one log file the unique identifier in association with the information that defines consumer activity. . . .”; even though,

Capiel lacks an explicit recitation of “storing in at least one log file the unique identifier in association with the information that defines consumer activity. . . .”

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Capiel (col. 12, ll. 9-43; col. 4, ll. 52-67; col. 5, ll. 38-67;

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col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) would have been selected in accordance with “storing in at least one log file the unique identifier in association with the information that defines consumer activity. . . .” because such selection would have provided means “*to identify the audience and tailor the advertising to that audience.*” (See Capiel (col. 1, ll. 22-24)).

As per claim 3, Capiel shows the method of claim 1. (See the rejection of claim 1 supra).

Capiel (col. 1, ll. 55-60; col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) shows elements that suggest the elements and limitations of claim 3.

Capiel lacks an explicit recitation of “identifying an IP [Internet Protocol] of the client computer, wherein the IP address is automatically logged in correspondence with the information that defines consumer activity; and associating the unique identifier with the IP address. . . .”

“Official Notice” is taken that both the concept and the advantages of “identifying an IP [Internet Protocol] of the client computer, wherein the IP address is automatically logged in correspondence with the information that defines consumer activity; and associating the unique identifier with the IP address. . . .” were well known and expected

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in the art by one of ordinary skill at the time of the invention because such concepts and advantages would have provided means “*to identify the audience and tailor the advertising to that audience.*” (See Capiel (col. 1, ll. 22-24)).

As per claim 4, Capiel shows the method of claim 1. (See the rejection of claim 1 supra).

Capiel (col. 1, ll. 55-60; col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) shows elements that suggest the elements and limitations of claim 4.

Capiel lacks an explicit recitation of the elements and limitations of claim 4. “Official Notice” is taken that both the concept and the advantages of “identifying connection specific information related to the established connection between the client computer and the one or more web sites, wherein the connection specific information is automatically logged in correspondence with the information that defines consumer activity; and associating the unique identifier with the connection specific information such that information that defines consumer activity can be extracted based on the association between the connection specific information and the unique identifier. . . .” were well known and expected in the art by one of ordinary skill at the time of the invention because such concepts and advantages would have provided means “*to identify the audience and tailor the advertising to that audience.*” (See Capiel (col. 1, ll. 22-24)).

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As per claim 5, Capiel shows the method of claim 1. (See the rejection of claim 1 supra).

Capiel (col. 1, ll. 55-60; col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) shows elements that suggest the elements and limitations of claim 5.

Capiel lacks an explicit recitation of the elements and limitations of claim 5.

“Official Notice” is taken that both the concept and the advantages of “wherein the unique identifier identifies a consumer’s electronic mail address. . . .” were well known and expected in the art by one of ordinary skill at the time of the invention because such concepts and advantages would have provided means “*to identify the audience and tailor the advertising to that audience.*” (See Capiel (col. 1, ll. 22-24)).

As per claim 6, Capiel shows the method of claim 1. (See the rejection of claim 1 supra).

Capiel (col. 1, ll. 55-60; col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) shows elements that suggest the elements and limitations of claim 6.

Capiel lacks an explicit recitation of the elements and limitations of claim 6.

“Official Notice” is taken that both the concept and the advantages of “wherein

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the one or more web sites include a plurality of links to other web pages located at a plurality of web servers. . . .” were well known and expected in the art by one of ordinary skill at the time of the invention because such concepts and advantages would have provided means “*to identify the audience and tailor the advertising to that audience.*” (See Capiel (col. 1, ll. 22-24)).

As per claim 7, Capiel shows the method of claim 6. (See the rejection of claim 6 supra).

Capiel (col. 1, ll. 55-60; col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) shows elements that suggest the elements and limitations of claim 7.

Capiel lacks an explicit recitation of the elements and limitations of claim 7. “Official Notice” is taken that both the concept and the advantages of “wherein the plurality of links to other web pages includes a link to a web page from where the consumer purchases merchandise. . . .” were well known and expected in the art by one of ordinary skill at the time of the invention because such concepts and advantages would have provided means “*to identify the audience and tailor the advertising to that audience.*” (See Capiel (col. 1, ll. 22-24)).

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As per claim 8, Capiel shows the method of claim 6. (See the rejection of claim 6 supra).

Capiel (col. 1, ll. 55-60; col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) shows elements that suggest the elements and limitations of claim 8.

Capiel lacks an explicit recitation of the elements and limitations of claim 8.

“Official Notice” is taken that both the concept and the advantages of “wherein the plurality of links to other web pages includes a link to a web page from where the consumer electronically views images of merchandise. . . .” were well known and expected in the art by one of ordinary skill at the time of the invention because such concepts and advantages would have provided means “*to identify the audience and tailor the advertising to that audience.*” (See Capiel (col. 1, ll. 22-24)).

As per claim 9, Capiel shows the method of claim 6. (See the rejection of claim 6 supra).

Capiel (col. 1, ll. 55-60; col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) shows elements that suggest the elements and limitations of claim 9.

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Capiel lacks an explicit recitation of the elements and limitations of claim 9. “Official Notice” is taken that both the concept and the advantages of “wherein the plurality of links to other web pages includes a link to a web page from where the consumer electronically contacts a seller. . . .” were well known and expected in the art by one of ordinary skill at the time of the invention because such concepts and advantages would have provided means *“to identify the audience and tailor the advertising to that audience.”* (See Capiel (col. 1, ll. 22-24)).

As per claim 10, Capiel shows the method of claim 1. (See the rejection of claim 1 supra).

Capiel (col. 12, ll. 9-43; col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) shows elements that suggest the elements and limitations of claim 10.

Capiel lacks an explicit recitation of the elements and limitations of claim 10. “Official Notice” is taken that both the concept and the advantages of “wherein information about the consumer’s movement within the one or more web sites is stored in a log file. . . .” were well known and expected in the art by one of ordinary skill at the time of the invention because such concepts and advantages would have provided means *“to identify the audience and tailor the advertising to that audience.”* (See Capiel (col. 1, ll. 22-24)).

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As per claim 11, Capiel shows the method of claim 10. (See the rejection of claim 10 supra).

Capiel (col. 12, ll. 9-43; col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) shows elements that suggest the elements and limitations of claim 11.

Capiel lacks an explicit recitation of the elements and limitations of claim 11.

“Official Notice” is taken that both the concept and the advantages of “wherein the log file includes the addresses of the one or more web sites. . . .” were well known and expected in the art by one of ordinary skill at the time of the invention because such concepts and advantages would have provided means “*to identify the audience and tailor the advertising to that audience.*” (See Capiel (col. 1, ll. 22-24)).

As per claim 12, Capiel shows the method of claim 10. (See the rejection of claim 10 supra).

Capiel (col. 12, ll. 9-43; col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) shows elements that suggest the elements and limitations of claim 12.

Capiel lacks an explicit recitation of the elements and limitations of claim 12.

“Official Notice” is taken that both the concept and the advantages of “wherein

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the log file includes information regarding number of times the consumer accesses a particular web site. . . .” were well known and expected in the art by one of ordinary skill at the time of the invention because such concepts and advantages would have provided means “*to identify the audience and tailor the advertising to that audience.*” (See Capiel (col. 1, ll. 22-24)).

As per claim 13, Capiel shows the method of claim 10. (See the rejection of claim 10 supra).

Capiel (col. 12, ll. 9-43; col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) shows elements that suggest the elements and limitations of claim 13.

Capiel lacks an explicit recitation of the elements and limitations of claim 13. “Official Notice” is taken that both the concept and the advantages of “wherein the log file includes information regarding any purchase the consumer makes while visiting the one or more web site. . . .” were well known and expected in the art by one of ordinary skill at the time of the invention because such concepts and advantages would have provided means “*to identify the audience and tailor the advertising to that audience.*” (See Capiel (col. 1, ll. 22-24)).

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As per claim 14, Capiel shows the method of claim 10. (See the rejection of claim 10 supra).

Capiel (col. 12, ll. 9-43; col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) shows elements that suggest the elements and limitations of claim 14.

Capiel lacks an explicit recitation of the elements and limitations of claim 14.

“Official Notice” is taken that both the concept and the advantages of “wherein the log file includes duration of the consumer’s visit to a particular web site. . . .” were well known and expected in the art by one of ordinary skill at the time of the invention because such concepts and advantages would have provided means “*to identify the audience and tailor the advertising to that audience.*” (See Capiel (col. 1, ll. 22-24)).

As per claim 15, Capiel shows the method of claim 10. (See the rejection of claim 10 supra).

Capiel (col. 12, ll. 9-43; col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) shows elements that suggest the elements and limitations of claim 15.

Capiel lacks an explicit recitation of the elements and limitations of claim 15.

“Official Notice” is taken that both the concept and the advantages of “developing

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a consumer master database based upon the log file; querying the master database; and determining consumer preferences. . . .” were well known and expected in the art by one of ordinary skill at the time of the invention because such concepts and advantages would have provided means “*to identify the audience and tailor the advertising to that audience.*” (See Capiel (col. 1, ll. 22-24)).

As per claim 16, Capiel shows the method of claim 15. (See the rejection of claim 15 supra).

Capiel (col. 12, ll. 9-43; col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) shows elements that suggest the elements and limitations of claim 16.

Capiel lacks an explicit recitation of the elements and limitations of claim 16. “Official Notice” is taken that both the concept and the advantages of “wherein the master database includes a plurality of segments including an email look up segment that includes a listing of a plurality of consumer electronic mail addresses with corresponding unique identifiers. . . .” were well known and expected in the art by one of ordinary skill at the time of the invention because such concepts and advantages would have provided means “*to identify the audience and tailor the advertising to that audience.*” (See Capiel (col. 1, ll. 22-24)).

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As per claim 17, Capiel shows the method of claim 15. (See the rejection of claim 15 supra).

Capiel (col. 12, ll. 9-43; col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) shows elements that suggest the elements and limitations of claim 17.

Capiel lacks an explicit recitation of the elements and limitations of claim 17.

“Official Notice” is taken that both the concept and the advantages of “wherein the master database includes a consumer information segment that contains consumer related information. . . .” were well known and expected in the art by one of ordinary skill at the time of the invention because such concepts and advantages would have provided means “*to identify the audience and tailor the advertising to that audience.*” (See Capiel (col. 1, ll. 22-24)).

As per claim 18, Capiel shows the method of claim 15. (See the rejection of claim 15 supra).

Capiel (col. 12, ll. 9-43; col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) shows elements that suggest the elements and limitations of claim 18.

Capiel lacks an explicit recitation of the elements and limitations of claim 18.

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“Official Notice” is taken that both the concept and the advantages of “wherein the master database includes a promotional material segment that includes information regarding promotional materials. . . .” were well known and expected in the art by one of ordinary skill at the time of the invention because such concepts and advantages would have provided means *“to identify the audience and tailor the advertising to that audience.”* (See Capiel (col. 1, ll. 22-24)).

As per claim 19, Capiel shows the method of claim 15. (See the rejection of claim 15 supra).

Capiel (col. 12, ll. 9-43; col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) shows elements that suggest the elements and limitations of claim 19.

Capiel lacks an explicit recitation of the elements and limitations of claim 19. “Official Notice” is taken that both the concept and the advantages of “wherein the master database includes a purchasing segment that includes information regarding purchases made by the consumers. . . .” were well known and expected in the art by one of ordinary skill at the time of the invention because such concepts and advantages would have provided means *“to identify the audience and tailor the advertising to that audience.”* (See Capiel (col. 1, ll. 22-24)).

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As per claim 20, Capiel shows the method of claim 15. (See the rejection of claim 15 supra).

Capiel (col. 12, ll. 9-43; col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) shows elements that suggest the elements and limitations of claim 20.

Capiel lacks an explicit recitation of the elements and limitations of claim 20. “Official Notice” is taken that both the concept and the advantages of “wherein the master database includes a URL segment that includes a plurality of URLs with corresponding keywords and plurality of keycodes associated with the keywords. . . .” were well known and expected in the art by one of ordinary skill at the time of the invention because such concepts and advantages would have provided means “*to identify the audience and tailor the advertising to that audience.*” (See Capiel (col. 1, ll. 22-24)).

As per claim 21, Capiel shows the method of claim 15. (See the rejection of claim 15 supra).

Capiel (col. 12, ll. 9-43; col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) shows elements that suggest the elements and limitations of claim 21.

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Capiel lacks an explicit recitation of the elements and limitations of claim 21. “Official Notice” is taken that both the concept and the advantages of “wherein the master database includes a credit card segment that includes consumer credit card number, date and amount of purchase by consumer. . . .” were well known and expected in the art by one of ordinary skill at the time of the invention because such concepts and advantages would have provided means “*to identify the audience and tailor the advertising to that audience.*” (See Capiel (col. 1, ll. 22-24)).

Claim 22 is rejected for substantially the same reasons as claim 1.

As per claim 23, Capiel shows the method of claim 22. (See the rejection of claim 22 supra).

Capiel (col. 1, ll. 55-60; col. 12, ll. 9-43; col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) shows elements that suggest the elements and limitations of claim 23.

Capiel lacks an explicit recitation of the “searching the log file for the unique identifier. . . .” elements and limitations of claim 23.

“Official Notice” is taken that both the concept and the advantages of “searching the log file for the unique identifier. . . .” were well known and expected in the art by one of ordinary skill at the time of the invention because such concepts and advantages would

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have provided means "*to identify the audience and tailor the advertising to that audience.*" (See Capiel (col. 1, ll. 22-24)).

Claim 24 is rejected for substantially the same reasons as claim 3.

Claim 25 is rejected for substantially the same reasons as claim 4.

Claim 26 is rejected for substantially the same reasons as claim 5.

Claim 27 is rejected for substantially the same reasons as claim 6.

Claim 28 is rejected for substantially the same reasons as claim 7.

Claim 29 is rejected for substantially the same reasons as claim 8.

Claim 30 is rejected for substantially the same reasons as claim 9.

Claim 31 is rejected for substantially the same reasons as claim 10.

Claim 32 is rejected for substantially the same reasons as claim 11.

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Claim 33 is rejected for substantially the same reasons as claim 12.

Claim 34 is rejected for substantially the same reasons as claim 13.

Claim 35 is rejected for substantially the same reasons as claim 14.

Claim 36 is rejected for substantially the same reasons as claim 15.

Claim 37 is rejected for substantially the same reasons as claim 16.

Claim 38 is rejected for substantially the same reasons as claim 17.

Claim 39 is rejected for substantially the same reasons as claim 18.

Claim 40 is rejected for substantially the same reasons as claim 19.

Claim 41 is rejected for substantially the same reasons as claim 20.

Claim 42 is rejected for substantially the same reasons as claim 21.

Claim 43 is rejected for substantially the same reasons as claim 21.

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Claim 44 is rejected for substantially the same reasons as claim 21.

As per claim 45, Capiel (col. 1, ll. 55-60; col. 12, ll. 9-43; col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) shows elements that suggest the elements and limitations of claim 45.

Capiel lacks an explicit recitation of the “logging the unique identifier in one or more log files in association with information that defines consumer activity within said one or more web sites, independent form any consumer profile information previously stored on the client computer by any servers. . . .”

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Capiel (col. 1, ll. 55-60; col. 12, ll. 9-43) would have been selected in accordance with “logging the unique identifier in one or more log files in association with information that defines consumer activity within said one or more web sites, independent form any consumer profile information previously stored on the client computer by any servers. . . .” because such concepts and advantages would have provided means “*to identify the audience and tailor the advertising to that audience.*” (See Capiel (col. 1, ll. 22-24)).

As per claim 46, Capiel shows the method of claim 45. (See the rejection of claim 45 supra).

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Capiel (col. 1, ll. 55-60; col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) shows elements that suggest the elements and limitations of claim 46.

Capiel lacks an explicit recitation of the elements and limitations of claim 46. “Official Notice” is taken that both the concept and the advantages of “Extracting the information that defines consumer activity based on its association with the unique identifier to track consumer movement. . . .” were well known and expected in the art by one of ordinary skill at the time of the invention because such concepts and advantages would have provided means “*to identify the audience and tailor the advertising to that audience.*” (See Capiel (col. 1, ll. 22-24)).

As per claim 47, Capiel shows the method of claim 45. (See the rejection of claim 45 supra).

Capiel (col. 1, ll. 55-60; col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) shows elements that suggest the elements and limitations of claim 47.

Capiel lacks an explicit recitation of the “identifying at least one connection and environment specific information related to the established connection between the consumer’s computer and the one or more web sites, wherein at least one of the

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connection and environment specific information is automatically logged in correspondence with the information that defines consumer activity. . . .” elements and limitations of claim 47.

“Official Notice” is taken that both the concept and the advantages of “identifying at least one connection and environment specific information related to the established connection between the consumer’s computer and the one or more web sites, wherein at least one of the connection and environment specific information is automatically logged in correspondence with the information that defines consumer activity. . . .” were well known and expected in the art by one of ordinary skill at the time of the invention because such concepts and advantages would have provided means *“to identify the audience and tailor the advertising to that audience.”* (See Capiel (col. 1, ll. 22-24)).

As per claim 48, Capiel shows the method of claim 47. (See the rejection of claim 47 supra).

Capiel (col. 1, ll. 55-60; col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) shows elements that suggest the elements and limitations of claim 48.

Capiel lacks an explicit recitation of “wherein at least one of the connection and environment specific information relates to IP address[sic] of the consumer’s computer. . . .”

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“Official Notice” is taken that both the concept and the advantages of “wherein at least one of the connection and environment specific information relates to IP address[sic] of the consumer’s computer. . . .” were well known and expected in the art by one of ordinary skill at the time of the invention because such concepts and advantages would have provided means “*to identify the audience and tailor the advertising to that audience.*” (See Capiel (col. 1, ll. 22-24)).

Claim 49 is rejected for substantially the same reasons as claim 7.

As per claim 50, Capiel shows the method of claim 47. (See the rejection of claim 47 supra).

Capiel (col. 1, ll. 55-60; col. 12, ll. 9-43; col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) shows elements that suggest the elements and limitations of claim 50.

Capiel lacks an explicit recitation of the elements and limitations of claim 50. “Official Notice” is taken that both the concept and the advantages of “wherein the unique identifier relates to electronic mail address[sic] of the consumer. . . .” were well known and expected in the art by one of ordinary skill at the time of the invention because such concepts and advantages would have provided means “*to identify the audience and tailor the advertising to that audience.*” (See Capiel (col. 1, ll. 22-24)).

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As per claim 51, Capiel shows the method of claim 47. (See the rejection of claim 47 supra).

Capiel (col. 1, ll. 55-60; col. 12, ll. 9-43; col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) shows elements that suggest the elements and limitations of claim 51.

Capiel lacks an explicit recitation of the elements and limitations of claim 51.

“Official Notice” is taken that both the concept and the advantages of “wherein the connection or environment specific information relates to an operating system executing on the consumer’s computer. . . .” were well known and expected in the art by one of ordinary skill at the time of the invention because such concepts and advantages would have provided means “*to identify the audience and tailor the advertising to that audience.*” (See Capiel (col. 1, ll. 22-24)).

As per claim 52, Capiel (col. 1, ll. 55-60; col. 12, ll. 9-43; col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) shows elements that suggest the elements and limitations of claim 52.

Capiel lacks an explicit recitation of the “IP address is recorded in a log file in association with the unique identifier. . . .” elements and limitations of claim 52.

It would have been obvious to a person of ordinary skill in the art at the time of the

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invention that the disclosure of Capiel (col. 1, ll. 55-60; col. 12, ll. 9-43) would have been selected in accordance with “wherein the IP address is recorded in a log file in association with the unique identifier. . . .” because such concepts and advantages would have provided means “*to identify the audience and tailor the advertising to that audience.*” (See Capiel (col. 1, ll. 22-24)).

#### **NEW CLAIM REJECTIONS — 35 U.S.C. §103(a)**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 75-82 are rejected under 35 U.S.C. §103(a) as being unpatentable over Capiel.

As per claim 75, Capiel (col. 1, ll. 55-60; col. 12, ll. 9-43; col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) shows elements that suggest the elements and limitations of claim 75.

Capiel lacks an explicit recitation of “embedding a unique identifier within a uniform resource locator (URL), the unique identifier identifying an email recipient, the URL identifying one or more web pages. . . .”

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Capiel (col. 1, ll. 55-60; col. 12, ll. 9-43; col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll.

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4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) would have been selected in accordance with “embedding a unique identifier within a uniform resource locator (URL), the unique identifier identifying an email recipient, the URL identifying one or more web pages. . . .” because such selection would have provided means “*to identify the audience and tailor the advertising to that audience.*” (See Capiel (col. 1, ll. 22-24)).

As per claims 76-77, Capiel shows the method of claim 75.

Capiel (col. 1, ll. 55-60; col. 12, ll. 9-43; col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) shows elements that suggest the elements and limitations of claims 76-77.

Capiel lacks an explicit recitation of some of the elements and limitations of claims 76-77, even though Capiel (col. 1, ll. 55-60; col. 12, ll. 9-43; col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) suggests same.

“Official Notice” is taken that both the concept and the advantages of the elements and limitations of claims 76-77 were well known and expected in the art by one of ordinary skill at the time of the invention because such concepts and advantages would have provided means “*to identify the audience and tailor the advertising to that audience.*” (See Capiel (col. 1, ll. 22-24)).

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As per claim 78, Capiel (col. 1, ll. 55-60; col. 12, ll. 9-43; col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) shows elements that suggest the elements and limitations of claim 78.

Capiel lacks an explicit recitation of “embedding a unique identifier within a uniform resource locator (URL), the unique identifier identifying an email recipient, the URL identifying one or more web pages. . . .”

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Capiel (col. 1, ll. 55-60; col. 12, ll. 9-43; col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) would have been selected in accordance with “embedding a unique identifier within a uniform resource locator (URL), the unique identifier identifying an email recipient, the URL identifying one or more web pages. . . .” because such selection would have provided means “*to identify the audience and tailor the advertising to that audience.*” (See Capiel (col. 1, ll. 22-24)).

As per claims 79-80, Capiel shows the system of claim 78.

Capiel (col. 1, ll. 55-60; col. 12, ll. 9-43; col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) shows elements that suggest the

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elements and limitations of claims 79-80.

Capiel lacks an explicit recitation of some of the elements and limitations of claims 79-80, even though Capiel (col. 1, ll. 55-60; col. 12, ll. 9-43; col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) suggests same.

“Official Notice” is taken that both the concept and the advantages of the elements and limitations of claims 79-80 were well known and expected in the art by one of ordinary skill at the time of the invention because such concepts and advantages would have provided means “*to identify the audience and tailor the advertising to that audience.*” (See Capiel (col. 1, ll. 22-24)).

As per claim 81, Capiel (col. 1, ll. 55-60; col. 12, ll. 9-43; col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) shows elements that suggest the elements and limitations of claim 81.

Capiel lacks an explicit recitation of “embedding a unique identifier within a uniform resource locator (URL), the unique identifier identifying an email recipient, the URL identifying one or more web pages. . .”

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Capiel (col. 1, ll. 55-60; col. 12, ll. 9-43; col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll.

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4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) would have been selected in accordance with “embedding a unique identifier within a uniform resource locator (URL), the unique identifier identifying an email recipient, the URL identifying one or more web pages. . . .” because such selection would have provided means *“to identify the audience and tailor the advertising to that audience.”* (See Capiel (col. 1, ll. 22-24)).

As per claim 82, Capiel shows the medium of claim 81.

Capiel (col. 1, ll. 55-60; col. 12, ll. 9-43; col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) shows elements that suggest the elements and limitations of claim 82.

Capiel lacks an explicit recitation of some of the elements and limitations of claim 82, even though Capiel (col. 1, ll. 55-60; col. 12, ll. 9-43; col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) suggests same.

“Official Notice” is taken that both the concept and the advantages of the elements and limitations of claim 82 were well known and expected in the art by one of ordinary skill at the time of the invention because such concepts and advantages would have provided means *“to identify the audience and tailor the advertising to that audience.”* (See Capiel (col. 1, ll. 22-24)).

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## RESPONSE TO ARGUMENTS

7. Applicant's arguments (Amendment D, filed 02/03/2003, paper#24) have been fully considered but they are not persuasive for the following reasons:

Applicant's arguments (Amendment D, paper#24, p. 7, ll. 5-23; and p. 8, ll. 1-8) appears to assert that as per "Claims 1, 22, 45, and 52. . . . The Examiner stated that Capiel lacks explicit recitation of all the elements in the claims, but took Official Notice that both the concept and advantages of said undisclosed elements were 'well known' and expected in the art by one of ordinary skill at the time of the invention." Then Applicant's arguments went further and demanded prior art evidence for said Official Notice taken.

However, a review of the prior Office Action shows that Official Notice was not cited for claims 1, 22, 45, and 52. Instead, the prior Office Action cited Official Notice for claims 3-21, 23-44 & 46-51.

It is well settled that "If Applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. *In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). A reasonable challenge constitutes a demand for evidence made as soon as practicable during prosecution. Thus, Applicant is charged with rebutting the well known statement in the next reply after the Office action in which the well known statement was made." (See MPEP 2144.03).

In this case, Applicant's response is silent as to a demand for references for the

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rejections of specifically claims 3-21, 23-44 & 46-51 and a rebuttal of the Officially Noticed well known statement evidence presented in the prior Office Action; therefore, said Official Notice evidence is deemed admitted, and no further references are required in support of said Official Notice evidence. Furthermore, Applicant's arguments Amendment D, paper#24, p. 7, ll. 5-23; and p. 8, ll. 1-8) amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. **However, if it was Applicant's intent to demand references for claims 3-21, 23-44 & 46-51, then upon such showing in a next response, the Office will consider such demand.**

Otherwise, the prior Office Action Official Notice is deemed admitted evidence.

Applicant's arguments (Amendment D, paper#24, p. 8, ll. 9-25; and p. 13, ll. 2-9) allege that "as admitted by the Examiner, the cited prior art reference fails to disclose, teach, or suggest each of the elements recited in claims 1, 22, 45, or 52. . . ." and that prima facie obviousness has not been established.

It is well settled that "Office policy is to follow *Graham v. John Deere Co.* in the consideration and determination of obviousness under 35 U.S.C. 103. . . ." by utilizing the Graham three pronged test of factual inquiries for determining obviousness:

(1) Determining the scope and contents of the prior art; (2) Ascertaining the differences between the prior art and the claims in issue; and (3) Resolving the level of ordinary skill in the pertinent art. (See MPEP 2141).

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In this case, and taken in the context of the factual inquires associated with *Graham v. John Deer Co.*, 383 U.S. 1, 86 S. Ct. 684, 15 L.Ed. 2nd 545 (1966), 148 USPQ 459 set forth above and the 35 USC §103(a) obviousness rejection requirements, the prior Office Action statement that “Capiel (col. 1, ll. 55-60) shows elements that suggest. . .” and that “Capiel lacks an explicit recitation of . . .” some of the elements and limitations of the various claims does not constitute an admission by the Office, that Capiel does not teach all of the elements and limitations of the claims at issue; furthermore, this is neither an acknowledgment of patentability nor an acknowledgment of non-obviousness nor an acknowledgment of any deficiency in the relied upon reference; to the contrary, when viewed in context, such recitations merely provide the grammatical transition phraseology to the factual inquires set forth in *Graham v. John Deer Co.*, 383 U.S. 1, 86 S. Ct. 684, 15 L.Ed. 2nd 545 (1966), 148 USPQ 459 and to the 35 USC §103(a) Obviousness proposition that even though the Capiel reference does not explicitly recite the claimed elements and limitations, the reference does in fact suggest the claimed elements and limitations of the instant invention; and therefore, the elements and limitations of the instant invention are rendered obvious because the prior Office Action (1) presents the scope and contents of the prior art as cited in each claim rejection; (2) the prior Office Action presents the differences between the prior art and the claims in issue by reciting what the prior art shows, what the prior art suggests and what the prior art discloses as well as indicates what the prior art fails to explicitly recite; and (3) the prior Office Action resolves the level of

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ordinary skill in the art by showing, suggesting and/or disclosing facts of record pertaining to the level of skill as found within the cited portions of the prior art of record. In this case, the prior Office Action states that Capiel shows elements that suggest the elements and limitations of the claimed invention. Therefore, based upon the above considerations, *prima facie* obviousness is established.

Applicant's arguments (Amendment D, paper#24, p. 9, ll. 14-19; p. 7, ll. 17-20) allege "there is not motivation to modify the reference to perform the claimed process and system of the present invention. . . ."

It is well settled in the law that "'There are three possible sources for motivation . . . the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.' *In re Ruffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). . . ." (See MPEP 2143.01).

In the prior Office Action obviousness rejections, the Examiner meets the requirements of the motivation test for modifying by citing from Capiel cogent reasons to modify the teachings of Capiel to produce the claimed invention; furthermore the Examiner identifies how the Capiel reference either teaches or suggests the elements of the claims of the instant invention. Furthermore, the Examiner relies on knowledge generally available to one of ordinary skill in the art of and asserts that the teachings of the Capiel reference combined with the knowledge of one of ordinary skill in the art either teaches or suggests all of the elements and limitations of the instant invention.

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Therefore, based upon the above considerations, *prima facie* obviousness is established.

Applicant's arguments (Amendment D, paper#24, p. 7, ll. 17-20; and p. 12) allege "the reference expressly teaches away from the claimed limitations of the present invention."

It is well settled in the law that "Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments." (See *In re Susi*, 169 USPQ 423 (CCPA 1971).

In this case, Applicant's arguments (Amendment D, paper#24, p. 8, ll. 21-22) admit that "The subject matter of the present invention is . . . at best remotely related, to that of the cited reference." Also, Applicant's arguments (Amendment D, paper#24, p. 13, ll. 10-11) admit that "Capiel indirectly suggests 'including the web site address in an electronic mail message sent to the email recipient. . . .'"

Applicant's arguments (Amendment D, paper#24, p. 9, ll. 14-19) allege that the Capiel reference "does not provide a convincing reason why the present invention, in particular, is related to that of the cited reference. . . ."

In this case, Applicant's arguments (Amendment D, paper#24, p. 8, ll. 21-22) admit that "The subject matter of the present invention is . . . at best remotely related, to that of the cited reference." Also, Applicant's arguments (Amendment D, paper#24, p. 13, ll. 10-11) admit that "Capiel indirectly suggests 'including the web site address in an

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electronic mail message sent to the email recipient. . . .” Note: It has been held that a prior art reference must either be in the field of Applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the Applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both references are in the field of Applicant’s endeavor and are both reasonably pertinent to the particular problem with which the Applicant is concerned according to Applicant’s admission above.

The remaining portions of Applicant’s arguments amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

The Office is in receipt of Applicant’s Declaration (paper#23) which has been entered. Said declaration presents secondary considerations; however said secondary considerations in view of the above obviousness rejections do not place the application in condition for allowance.

#### **RELEVANT PRIOR ART**

8. The prior art references made of record and not relied upon are considered pertinent to applicant's disclosure:

**U.S. Patent Documents**

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6,065,048, U.S. Pat. [May 16, 2000]      Highley,      709/206

“METHOD AND SYSTEM FOR REMOTELY SENSING THE FILE FORMATS PROCESSED BY AN E-MAIL CLIENT.” This references discusses “embedding a unique identifier within a web site address.” Ref. claims 1-52 & 75-82.

5,864,871, U.S. Pat. [Jan. 26, 1999]      Kitain et al.,      707/104.1

“INFORMATION DELIVERY SYSTEM AND METHOD INCLUDING ON-LINE ENTITLEMENTS.” This references discusses embedding unique identifiers in e-mail addresses. Ref. claims 1-52 & 75-82.

## CONCLUSION

9. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

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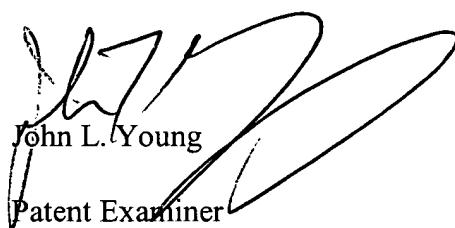
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

  
John L. Young  
Patent Examiner

April 21, 2003